

REMARKS

In the Official Action mailed January 22, 2008, claims 1-11 are pending. Claims 1-11 were rejected. The rejection is respectfully traversed. Claim 1 has been amended to include the additional elements of a first pincer fixed in a position relative to the shaft, a second pincer which rotates about a single point of rotation and an actuation mechanism that is slidable when a pushing force is exerted on it. Claim 6 has been amended to include the additional elements of a first pincer being in a rigidly fixed position, a second pincer rotatable about a single point of rotation, and a sliding element which closes or opens only the second pincer relative to the fixed first pincer and which slides along a shaft of the instrument when a pushing force is exerted on it. Applicants have thoroughly reviewed the outstanding Official Action, including the Examiner's remarks and the references cited therein.

The following remarks are believed to be fully responsive to the Official Action, which is discussed below. All the pending claims at issue are believed to be patentable over the cited references. Reconsideration and withdrawal of the outstanding rejections are respectfully requested in view of the following remarks.

Claims 1-9 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,122,130 ("Keller"). Keller, as discussed in the previous Office Action, discloses an implant holding instrument 23 including a U-shaped holding element with legs 24 and 25. A screw 26, located at the proximal end of the instrument 23, may be turned which creates a tensile force on both legs 24 and 25. By turning the screw 26, the outer tube 28 presses against both legs 24 and 25 so that both legs 24 and 25 are pressed inwardly together to hold the implant securely. (Keller col.5 ll.61 to col.6 ll.5.)

Contrary to the Examiner's assertions, it is respectfully submitted that Keller does not teach each and every element of the present invention. Specifically, Keller does not teach a "first pincer which is in a fixed position relative to the shaft," as claimed in claim 1, for example. Keller teaches that both legs 24 and 25 move by bending to securely hold the implant. In the present invention, only one of the pincers moves to securely hold the implant. The first pincer remains in a fixed position whether the instrument is in the open position or in the closed position, holding the implant.

Moreover, Keller does not include a second pincer which rotates "about a single point of rotation," as claimed in claim 1, for example. Keller teaches that legs 24 and 25 bend along a portion of the legs, near the base of the legs. Applicant respectfully submits that the bending along a portion of the legs 24 and 25 does not constitute rotation about a single point of rotation. Figures 8a and 8b of this application, for example, illustrate rotation about a single point. The second pincer rotates about an axis 813, or pin, relative to the first pincer, which provides a smooth and consistent circular path of rotation of the second pincer. In Keller, the legs 24 and 25 bend, as any material would, at various points along the base of the legs, providing inconsistent bending and an imperfect path of travel of legs 24 and 25.

The imperfect path, furthermore, is not suggestive of a pivot. The legs 24 and 25 of Keller are pressed together, and a specific point of rotation, required to create a circular path of travel, is nonexistent. Keller incorporates a "cut" in between legs 24 and 25 to allow the legs to press together. Applicant respectfully asserts that this cannot be a "pivot" or a "rotation" since the legs are merely bent together.

Finally, Keller discloses a tube 28 and drawbar 29, which connect to the holding element parts 24 and 25. The drawbar 29 is moved using a screw 26 located at the end of the handle. (Col.5 l.61 to col.6 l.5.) The present invention as claimed, however, uses a pushing motion to slide the actuation mechanism, as claimed in claim 1. The present invention does not include a thread or screwing motion. Instead, the present invention uses a pushing motion to engage the actuation mechanism with the second pincer.

Examiner also rejected claims 1 and 6-11 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 640,038 ("Koch") in view of U.S. Patent No. 4,304,157 ("Yamada et al."). Koch discloses a wrench including two opposing jaws B and C. The wrench may have one jaw that is fixed and one that is movable, using a screw-actuated "setting-rod" g and pin e. The pin moves within a slot in jaw C, which is adjusted by turning the screw I,i. Yamada et al. discloses a torque wrench including a lever that is forced outward by a disengageable spring-loaded cam. The lever is biased by the spring-loaded cam to maintain contact with the ratchet wheel.

It is respectfully submitted that neither Koch nor Yamada et al., alone or in combination, disclose each and every element of the claimed invention as required by 35 U.S.C. § 103.

Koch does not disclose a biased second pincer, nor does it disclose an actuation member that is slidable by a pushing force being applied to it. Instead, Koch discloses a typical pipe wrench where its jaws are adjusted using screw I,i. The pin e appears to be in constant contact with the second jaw C in order to maintain its distance from the first jaw B. This constant contact is required because the second jaw does not have a bias force acting on it.

Yamada et al. does not add all the elements that are missing in *Koch*, and that are required to maintain the § 103 rejection. Namely, neither *Koch* nor *Yamada et al.* discloses an actuating member that slides along the shaft of the instrument through a pushing motion exerted upon it. Instead, *Koch* discloses a member that moves according to a threading of the screw. *Yamada et al.* does not disclose a sliding member to correct this deficiency.

Moreover, *Yamada et al.* does not disclose a bias of a second jaw between an implant holding position and an implant release position. *Yamada et al.* disclose a bias in a ratchet — gear wheel configuration. *Yamada et al.* does not disclose two jaws, one of which is biased apart from the other.

Finally, Applicant asserts that neither *Koch* nor *Yamada et al.* discloses an implant holding instrument, and an instrument that can be used inside a body of an animal. The present invention is within the field of orthopedic medical devices, and neither of these cited references even considers such a field.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone Applicants' attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

Application No.: 10/771,597

Docket No.: SPINE 3.0-447 CONT

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: July 22, 2008

Respectfully submitted;

By 

Brian R. Tomkins

Registration No.: 58,550

LERNER, DAVID, LITTENBERG,

KRUMHOLZ & MENTLIK, LLP

600 South Avenue West

Westfield, New Jersey 07090

Attorney for Applicants

898719_1.DOC